

REMARKS

After the amendments, claims 50-54 and 83-109 will be pending in the application. Claims 50-54 have been withdrawn from consideration. Claims 96-109 are new. Claims 83-95 stand rejected.

Claims 83, 89 and 91-93 have been amended. Support for the amendments to claim 83 can be found, *inter alia*, at paragraphs [0145]-[0148] and in Figs. 49 and 52 of the specification.¹ Support for the amendments to claims 91-93 can be found, *inter alia*, at paragraphs [0157]-[0159] and in Fig. 55 of the specification. Claim 89 is amended only to reflect the proper antecedent basis.

Claims 96-109 have been added. Support for new claims 96, 97, 100 and 107 can be found, *inter alia*, at paragraph [0092] of the specification. Support for new claims 98 and 109 can be found, *inter alia*, at paragraphs [0008] and [0145]. Support for new claims 99-103 can be found, *inter alia*, at paragraphs [0146]-[0152] and [0157] and in Figures 49, 52 and 55. Support for new claims 104-106 and 108 can be found, *inter alia*, at paragraphs [0149]-[0154] and in Figures 49 and 53A.

No new matter is added by the amendments.

Applicants have reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicants submit that the following remarks are fully responsive to the final Office action, and that all pending claims are patentable over the cited references.

Rejections Under 35 U.S.C. § 102

The Examiner rejects claims 83, 89, 90, and 94 under 35 U.S.C. § 102(b) as anticipated by United States patent no. 4,207,874 to Choy ("Choy") and United States patent no. 6,139,492 to Vierra et al. ("Vierra"). To be anticipatory, a single prior art reference must explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d

¹ References are to the published application, US2004/0260278 (Dec. 23, 2004).

628, 631 (Fed. Cir. 1987)). Applicants respectfully submit that neither Choy nor Vierra meets this standard.

Claim 83 recites “an ablating device adapted to temporarily mechanically couple to a tissue surface” and “at least one suction well that surrounds a perimeter of the at least one ablating element, wherein a closed wall defined by an inner lip of the at least one suction well surrounds the perimeter of the at least one ablating element.” Choy discusses a laser tunneling device intended to break apart an obstruction within a tube (e.g., a blood vessel) and that utilizes suction to remove the pieces of the obstruction so broken. Choy, 3:6-8 (“The laser energy vaporizes the obstruction, *which is constantly removed by the suction ...*”) (emphasis added); 4:48-53. Thus, Choy fails to teach or disclose at least “an ablating device adapted to temporarily mechanically couple to a tissue surface” as recited in claim 83.

Choy also fails to teach or disclose “at least one suction well that *surrounds a perimeter* of the at least one ablating element, wherein a closed wall *defined by an inner lip of the at least one suction well* surrounds the perimeter of the at least one ablating element.” The Examiner asserts that “the portion of the device distal of the tip of the optical fiber [e.g., head 18] constitutes a suction well” Office action, p.2. It is clear from Figs. 1 and 2 of Choy, however, that head 18 of the device does not “surround a perimeter of” the optical fiber. Nor does Choy’s head 18 have an inner lip that defines a closed wall that surrounds the perimeter of the at least one ablating element. Accordingly, Applicants respectfully submit that Choy does not teach or disclose, either explicitly or inherently, each and every element of the claimed invention.

As to Vierra, the Examiner does not provide any citations in support of the assertion that Vierra allegedly anticipates the claimed invention. Applicants respectfully submit that Vierra does not teach or suggest “[a]n elongate body having at least one ablating element” as recited in claim 83. It follows that Vierra does not teach or suggest “at least one suction well that surrounds a perimeter of the at least one ablating element” or “a closed wall defined by an inner lip [that] surrounds the perimeter of the at least one ablating element.” Vierra therefore cannot anticipate claim 83.

For at least the foregoing reasons, Applicants respectfully submit that neither Choy nor Vierra anticipates claim 83. Claims 89, 90, and 94, which depend from claim 83, are allowable for at least the same reasons. Accordingly, Applicants respectfully request withdrawal of these rejections.

Rejections Under 35 U.S.C. § 103

The Examiner rejects claims 84-88, 91-93, and 95 under 35 U.S.C. § 103 as obvious over Choy. Applicants respectfully disagree.

Claims 84-88, 91-93, and 95 depend from claim 83. The shortcomings of Choy with respect to claim 83 are discussed at length above. Applicants submit that the Examiner has not met the burden of establishing a *prima facie* case that independent claim 83 is obvious over Choy. Therefore, dependent claims 84-88, 91-93, and 95 are non-obvious over Choy because the independent claim from which they depend is non-obvious over the cited reference. MPEP 2143.03; *In re Fine*, 837 F.2d at 1076. Furthermore, Applicants submit that the differences between the rejected claims and the reference cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. See 35 U.S.C. § 103.

For at least these reasons, Applicants respectfully submit that claims 84-88, 91-93, and 95 are substantially different from, and therefore non-obvious over Choy. Accordingly, Applicants respectfully request withdrawal of this rejection.

The Examiner states that claims 84-88, 91-93, and 95 are obvious over Vierra, but in the argument the Examiner also refers to Choy. Thus, the exact basis for the Examiner's rejection is not clear. However, Applicants submit that claims 84-88, 91-93, and 95 are substantially different from, and therefore non-obvious over Choy and Vierra either alone or in combination.

Claims 84-88, 91-93, and 95 depend from claim 83. The shortcomings of Vierra and Choy with respect to claim 83 are discussed above. Applicants submit that the

Examiner has not met the burden of establishing a *prima facie* case that independent claim 83 is obvious over Choy and/or Vierra. Therefore, dependent claims 84-88, 91-93, and 95 are non-obvious because the independent claim from which they depend is non-obvious over the cited references. MPEP 2143.03; *In re Fine*, 837 F.2d at 1076. Furthermore, Applicants submit that the differences between the rejected claims and the references cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. See 35 U.S.C. § 103.

For at least these reasons, Applicants respectfully submit that claims 84-88, 91-93, and 95 are substantially different from, and therefore non-obvious over Choy, Vierra and the combination of the two. Accordingly, Applicants respectfully request withdrawal of this rejection.

Double Patenting Rejections

The Examiner rejects claims 83-95 on the ground of non-statutory, obviousness-type double patenting over claims 1-25 of United States patent no. 5,830,214 to Flom et al. ("Flom"). Applicants submit that this rejection is improper because Flom is not commonly-owned with the present application. MPEP § 804.

The Examiner provisionally rejects claims 83-95 of the ground of non-statutory, obviousness-type double patenting over claims 1-25 of United States application no. 11/882,072. Applicants will submit a terminal disclaimer to overcome this double patenting rejection upon receiving an indication of allowable subject matter in the application.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that the application is in condition for allowance, and request that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension of time is believed necessary for this paper to be considered timely. Should an extension of time be deemed necessary, Applicants hereby petition therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0E-040042US/82410-0181.

Respectfully submitted,

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